

## **REMARKS**

Applicants reply to the Office Action mailed on August 8, 2005, within the shortened statutory period for reply. Claims 1-12 were pending and the Examiner rejects claims 1-12. In reply, Applicants amend claims 1-12, add claims 13-15 and address the Examiner's remarks. Support for the amendments may be found in the originally-filed specification, claims, and figures. No new matter has been introduced by these amendments. Reconsideration of this application is respectfully requested.

The Examiner advised Applicants that under 37 C.F.R. § 1.56, Applicants are obligated to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made. Applicants respectfully assert that the subject matter of the various claims was commonly owned at the time the inventions covered therein were made and therefore, Applicants have complied with 37 C.F.R. § 1.56.

## **DOUBLE PATENTING**

The Examiner provisionally rejects claims 1-12 over claims 1-12 of co-pending Application Serial No. 10/708,841. While Applicants respectfully disagree with this double patenting rejection, in the interest of compact prosecution, Applicants submit a terminal disclaimer, without prejudice, in compliance with 37 C.F.R. § 1.321(c). Applicants also assert that this non-statutory double patenting rejection is based on the above-listed application, which is commonly owned with this application by assignee, American Express Travel Related Services Company, Inc.

## **35 U.S.C. § 103 REJECTIONS**

### ***Rejections Under 35 U.S.C. § 103 (a)–the Renner, Black and Janiak References***

The Examiner rejects claims 1-12 under 35 U.S.C. § 103(a) as being unpatentable over Renner et al., U.S. Patent No. 6,223,984 (“Renner”), in view of Black, U.S. Patent Application No. 2005/0122209 (“Black”) and Janiak et al., U.S. Patent Application No 2002/0030581 (“Janiak”). Regarding claim 1, the Examiner asserts that “Renner et al. teaches that a optional PIN keypad can be used in order to force a user to enter a personal identification number (PIN) to authorize transactions above a certain limit (FIG. 7, 734). This is interpreted as determining if

a transaction violates an established rule, and authorizing the transaction that violates an established rule upon PIN verification.” (Page 6) Applicants respectfully traverse.

Renner generally discloses a card reader which accepts different types of smart cards and emulates various peripheral devices such as magnetic stripe readers, bar code readers, and Wiegand effect readers. While Renner discloses an “[o]ptional PIN keypad...to force a user to enter a personal identification number (PIN) to authorize transactions above a certain predetermined limit” (col. 13: lines 39-42), Renner is silent as to biometrics. That is, as the Examiner admits, Renner “is silent to notifying a user to proffer a biometric sample, detecting a biometric sample at a sensor communicating with the system to obtain a proffered biometric sample, verifying the biometric sample, and authorizing the transaction upon verification of the sample.” (Page 7).

The Examiner then cites Black for teaching “replacing PIN codes with fingerprint matching.” (Page 7). In general, Black discloses an identity authentication system comprising a device for capturing a customer signature. Black requires a user to provide an electronic signature using a stylus or other similar device ([0016], [0022]). Further still, the Examiner claims that “[t]hough Black in some embodiments is drawn to a RFID/transponder, the Examiner notes that Black states that such teachings can apply to smartcards as well.” (Page 7). However, neither Renner, Black, Janiak, nor any combination thereof, discloses or suggests at least “determining if a transaction violates at least two established rules,” as recited in independent claim 1.

For example, a phone can be used to perform a transaction (e.g., telephone banking), wherein a user may be prompted to enter a PIN on the phone keypad to facilitate that transaction. However, it is not obvious, nor easy, to modify the phone to accept biometrics instead of a PIN. This is because biometric sensor technology is far more complicated than PIN technology, and processing a biometric sample requires much more complex hardware and software.

Further, in order to verify a PIN, usually only 4-8 digits (i.e., data points) need to be verified. In contrast, a biometric contains thousands to millions of data points that are far more complicated and complex. Similarly, the step of “determining if a transaction violates at least two established rules,” as similarly recited in independent claim 1, adds a much higher level of security compared to a determination of whether a transaction violates a single established rule. For example, in order to determine whether a transaction violates a single rule, a simple “if,

then” statement can be used to process the rule violation. However, once an additional rule level is added, the number of possible results grows exponentially, requiring more complex software and hardware systems. Thus, it is not obvious to combine the system of Renner to that of Black, because the combination would require non-obvious complex hardware and software modifications to accommodate both the rule statements and the technology variations.

Claims 2-12 directly depend from claim 1 and contain all of the elements thereof. Therefore, Applicants assert that claims 2-12 are differentiated from the cited reference at least for the same reasons as set forth above, in addition to their own respective features. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 2 and 4-12.

With respect to claim 3, the Examiner further admits that “Renner et al/Black are silent to notifying a user to proffer a biometric sample (audibly/visually/mechanically/etc. re claim 3” (Page 9), however the Examiner asserts that Janiak “teaches requesting biometric data by a display to a user, to facilitate a transaction (see claim 45 of Janiak et al., for example).” (Page 9). Applicants respectfully traverse.

Neither Renner, Black, Janiak, nor any combination thereof, teach or disclose at least “determining if a transaction violates at least two established rules,” as recited in claim 3. Moreover, claim 3 indirectly depends from claim 1 and contains all of the elements thereof. Therefore, Applicants respectfully submit that claim 3 is differentiated from the cited references at least for the same reasons as set forth above, in addition to its own respective features. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 3.

#### **NEW CLAIMS 13-15**

New claims 13-15 depend from claim 1 and contain all of the elements thereof. Therefore, Applicants assert that new claims 13-15 are differentiated from the cited references at least for the same reasons as set forth above, in addition to their own respective features.

#### **CONCLUSION**

Applicants respectfully submit that the pending claims are in condition for allowance. No new matter is added in this Reply. Reconsideration of the application is thus requested. **The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. 19-2814.** Applicants invite the Examiner to telephone the undersigned if the Examiner has any questions regarding this Reply or the application in general.

Respectfully submitted,

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